

**REMARKS**

Claims 16-28 are rejected under 35 U.S.C. 102(b) as being anticipated by Chow U.S. Patent No. 5,955,028 (hereafter "Chow"). Claims 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chow in view of Anderson *et al.* U.S. Patent No. 5,922,591 (hereafter "Anderson"). Applicant respectfully traverses these rejections.

Rejection of Claims Under 35 USC §102(b)

Claim 16 recites:

"a handheld housing including the data processing and control unit, and the detection system, wherein the data processing and control unit and the detection system are permanently fixed in the housing, and the microfluidic system is insertable and removable from the housing."

In contrast, Chow requires a system in which the adaptor, the base unit, and the sample substrate are all separate components. (Chow, Col. 4, lines 27-50). Chow teaches a system having at least three separate components, referred to as tiers, that can be joined together to form a system. Chow does not teach or even suggest a system configured as set forth in Claim 16, which essentially includes two tiers, but instead Chow teaches systems having three, four, or more tiers. Chow's system as described cannot be configured as a two tier system where the microfluidic system is couplable to communicate with the control unit. A novel sample substrate and control unit design is needed to implement a two tier system as in claim 16. Claim 16 is therefore believed to be allowable over Chow.

Rejection of Claims Under 35 U.S.C. § 103

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See MPEP Section 2142. In the present case, the combination of Chow

and Anderson does not teach or suggest all of the claim limitations because neither Chow or Anderson, alone or in combination, teach or even suggest a system configured as set forth in Claim 16, which essentially includes two tiers as discussed hereinabove. Instead, Anderson teaches a system having one tier, while Chow teaches a system having three, four, or more tiers. Claim 16 is therefore believed to be allowable over Chow and Anderson, both alone, and in combination.

Claims 17-30, and 47-57 depend from Claim 16 and include features that further distinguish them from the prior art. Allowance of Claims 16-30 and 47-57 is requested.

#### Canceled Claims

Claims 1-15 have been canceled without prejudice.

#### New Claims

Dependent Claims 47-57 have been added to capture subject matter that was originally disclosed in the specification. Claims 47, 48, and 55 are supported at least by Figure 1a and page 11 lines 21-24 in the specification; Claim 49 is supported at least by page 14, lines 9-16; Claim 50 is supported at least by page 24, lines 11-23; Claims 51-53 is supported at least by Figure 3d and page 25 lines 12-30 through page 26 lines 1-10; Claim 54 is supported at least by page 27 line 10 through page 29 line 8; Claim 56 is supported at least by page 13 lines 20 through 23; Claim 57 is supported at least by page 13 lines 10 through 12. Examination of Claims 47-57 is respectfully requested.

#### CONCLUSION

Claims 16-30, and 47-57 are believed to be in condition for allowance and a notice to that effect is solicited. Should any issues arise that might be subject to resolution through a telephone interview, the Examiner is requested to contact the undersigned at (949) 251-0250. In the event it would facilitate prosecution of this application, the Examiner is invited to telephone the undersigned at (949) 251-0250.

I hereby certify that this correspondence is being facsimile transmitted to the USPTO, Central Number at (703) 872-9306 on the date shown below:

(Signature)

Mary Jo Bertani

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September 17, 2004

(Date)

Respectfully submitted,

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